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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/064,264
Filing Date: June 26, 2002
Appellant(s): GORDON, JASON A.

Martin F. Noonan
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 16 January 2007 appealing from the Office action mailed 16 August 2006.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,995,950	Barns-Slavin et al.	11-1999
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5,072,401	Sansone et al.	12-1991
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Huxter, United States Publication No. 2002/0107820 A1, 1 January 2001

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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. As per Claim 19, the recitation of the phrase "the incentive is a penalty" is vague and indefinite. It is unclear to the Office what the Applicant means by incentive. Appropriate correction is required in the indicated claim and any subsequent recitations.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 10 and 14-19 are rejected under 35 U.S.C. 102(b) as being anticipated by

Barns-Slavin et al., U.S. Patent No. 5,995,950.

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As per **Claims 1 and 10**, Barns-Slavin et al. disclose a mailing machine comprising:

- a processor (Col. 2, lines 20-47);
- a first memory portion operatively connected to the processor for concurrently storing a primary rate database (Col. 2, lines 20-47);
- a second memory portion operatively connected to the processor for storing temporary rate data (Col. 3, lines 45-49);
- a third memory portion operatively connected to the processor for storing rating instruction data (Col. 2, lines 20-47); and
- wherein the processor determines a rate applicability determination using the rating instruction data, the primary rate database and the temporary data (Col. 2, lines 20-47).

As per **Claim 16 and 19**, Barns-Slavin et al. disclose a mailing machine comprising:

- obtaining customer usage and customer data (Col. 2, lines 7-10; Col. 4, lines 48-50);
- determining whether offering an incentive is desired (Col. 4, lines 19-25);
- determining whether a customer is eligible for an incentive (Col. 2, lines 20-47);
- offering the customer the incentive (Col. 3, lines 37-44);
- obtaining incentive related usage data (Col. 2, lines 7-10); and
- analyzing the incentive related usage data to determine effectivity, determining whether to modify the incentive (Col. 2, lines 20-67).

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As per **Claim 17**, Barns-Slavin et al. disclose a mailing machine comprising:

- the customer usage data is obtained from a mailing machine (Col. 2, lines 7-10).

As per **Claim 18**, Barns-Slavin et al. further discloses a mailing machine wherein:

- the incentive is a time based discount for at least one particular class of mail
(Col. 2, lines 7-10).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 2-5, 8-9 and 11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Barns-Slavin et al., U.S. Patent No. 5,995,950.

As per **Claims 2 and 11**, Barns-Slavin et al. further discloses a mailing machine comprising:

- wherein the processor determines a rate determination using the rating instruction data and usage data and determines a rate applicability determination using the rate determination and the primary rate database (Col. 2, lines 20-47).

Barns-Slavin et al. fails to *explicitly* disclose a fourth memory portion operatively connected to the processor for storing usage data. However, Barns-Slavin et al. disclose discounts being

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allowed only after a certain amount of items have been shipped (Col. 2, lines 7-10). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the mailing machine of Barns-Slavin et al. and include storing the usage data within a memory, because it provides an easily implemented and flexible system for determining discounted shipping charges for users.

As per **Claim 3**, Barns-Slavin et al. further discloses a mailing machine comprising:

- wherein the processor determines a rate applicability determination further using the temporary rate database.

Barns-Slavin et al. fails to disclose a temporary rate data comprises a temporary rate database having expiration data. However, Barns-Slavin et al. discloses replaceable memory so that rate data may be updated from time to time (Col. 3, lines 45-49). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the mailing machine of Barns-Slavin et al. and include a temporary rate database having expiration data, because it greatly improves the system by providing the system with more accurate rate data to determine the discount for the user.

As per **Claim 4**, Barns-Slavin et al. fails to *explicitly* disclose wherein:

- a portion of the rate applicability determination is received from an external processor and stored in the temporary rate database.

However, Barns-Slavin et al. discloses a temporary rate database, which may be updated by downloading (from an external processor) to writeable memory (Col. 3, lines 45-49). Therefore,

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it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the mailing machine of Barns-Slavin et al. and include a portion of the rate determination data being received by an external processor, because it greatly improves the system by providing the system with more accurate rate data to determine the discount for the user.

As per Claim 5, Barns-Slavin et al. fails to *explicitly* disclose wherein:

- a fifth memory portion operatively connected to the processor for storing customer data.

However, Barns-Slavin et al. discloses inputting customer information into the system (Col. 4, lines 48-50). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the mailing machine of Barns-Slavin et al. and include storing the customer data in a memory, because it provides an easily implemented and flexible system for determining discounted shipping charges for users.

As per Claim 8, Barns-Slavin et al. further discloses wherein:

- the temporary rate data is cleared periodically (Col. 3, lines 45-49).

As per Claim 9, Barns-Slavin et al. further fails to disclose a mailing machine wherein:

- the period for clearing the temporary rate data is every 24 hours.

However, Barns-Slavin et al. discloses wherein the temporary rate data is updated from time to time (Col. 3, lines 45-49). Therefore, it would have been obvious to one of ordinary skill in the

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art at the time of applicant's invention to modify the mailing machine of Barns-Slavin et al. and include updating the temporary rate data from time to time, because it greatly improves the system by providing the system with more accurate rate data to determine the discount for the user.

8. Claims 12-13 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barns-Slavin et al., U.S. Patent No. 5,995,950 in view of Sansone et al., U.S. Patent No. 5,072,401

As per Claim 12, Barns-Slavin et al. further discloses a mailing machine comprising:

- receiving customer data for a plurality of customers (C. 2, lines 10-13, Col. 3, lines 37-50);
- creating a temporary rate database (Col. 3, lines 45-49);
- sending the temporary rate database to the mailing machine (Col. 3, lines 45-49).

Barns-Slavin et al. fails to *explicitly* disclose receiving customer data for a plurality of customers.

However, Barns-Slavin et al. discloses receiving usage data of a customer (Col. 2, lines 7-10).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the mailing machine of Barns-Slavin et al. and include receiving usage data from a plurality of customers, because it provides an easily implemented and flexible system for determining discounted shipping charges for users.

Barns-Slavin et al. fails to disclose:

- obtaining logistics data for a mailing logistics system (Col. 3, lines 50-65);

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- determining desired volume changes by class (Col. 3, lines 50-65);
- targeting at least one customer having a mailing machine for a discount in the class (Col. 16, lines 3-6).

However, Sansone et al. teaches a mailing system which obtains logistics data for a mailing logistics system, determines the volume changes of batch mail, and determines which mailers to provide a discount to (Col. 3, lines 50-65; Col. 16, lines 3-6). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the mailing machine of Barns-Slavin et al. and include obtaining logistics data, determining volume changes by class, and targeting customers of that class for a discount as taught by Sansone et al., because it greatly improves the system by enabling a more efficient and effective use of the facilities of the post office.

As per Claim 13, Barns-Slavin et al. fails to disclose a mailing machine comprising:

- receiving data relating to customer usage of the discount; and determining whether to adjust the discount.

However, Sansone et al. teaches a data center which stores usage data of the mailers and determines whether the mailers qualify for extra discounts based on their use of previous discounts (Col. 4, lines 25-43). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the mailing machine of Barns-Slavin et al. and include determining whether to adjust the users discounts based on their usage of the discounts as taught by Sansone et al., because it greatly improves the system by providing the users with greater discounts they would not ordinarily be available to them.

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As per Claim 20, Barns-Slavin et al. further discloses a mailing machine wherein:

- determining whether an incentive is desired includes, analyzing historical usage data (Col. 2, lines 7-10; Col. 4, lines 19-25).

Barns-Slavin et al. fails to *explicitly* disclose analyzing partial period usage data. However, Barns-Slavin et al. discloses analyzing usage data (Col. 2, lines 7-10). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the mailing machine of Barns-Slavin et al. and include analyzing partial period usage data, because it greatly improves the efficiency of the system by providing the system with more accurate rate data to determine the discount for the user.

Barns-Slavin et al. fails to disclose forecasting capacity demands and targeting at least one customer likely to require the applicable mailing services to be discounted. However, Sansone et al. teaches using logistics planning in order to ensure timely delivery of mailings, and also targets mailers with common usage patterns (Col. 3, lines 50-65; Col. 16, lines 3-6). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the mailing machine of Barns-Slavin et al. and include forecasting capacity demands and targeting customers with common usage patterns as taught by Sansone et al., because it greatly improves the system by enabling a more efficient and effective use of the facilities of the post office.

9. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barns-Slavin et al., U.S. Patent No. 5,995,950 in view of Huxter, Pub. No. US2002/0107820 A1.

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As per **Claims 6-7**, Barns-Slavin et al. fails to disclose a mailing machine comprising:

- at least a portion of the customer data is obtained utilizing a cookie, and at least a portion of the rate determination is received from an external processor that received the cookie.

However, Huxter teaches using cookies to obtain user information (Paras. 180 and 183).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the mailing machine of Barns-Slavin et al. and include cookies to obtain customer data as taught by Huxter, because it greatly improves the convenience of the system by providing the user with convenience and a system that is user-friendly.

(10) Response to Argument

First Issue

Regarding the Appellant's arguments that the Patent Office has fails to establish a *prima facie* case of obviousness, the Examiner asserts that the combination of references, i.e. Barns-Slavin et al. in view of Sansone et al., is proper. In this case, one of ordinary skill in the art would have been led to combine Barns-Slavin et al. and Sansone et al. in view of the fact that both references are directed to mail delivery systems. Further, both systems are aimed at providing mail users with discounts after certain requirements or qualifications have been met. For instance, Barns-Slavin discloses an object of the invention is to provide a carrier management system having an easily implemented and flexible system for determining discounted shipping charges. Further, Sansone et al. teaches a system which merges mailings into batches which will qualify for extra discounts. Sansone et al. discloses that the principal of

the invention is to provide a system that enables a more efficient and effective use of the facilities of the post office. The Appellant's own arguments are inline with Barns-Slavin et al. and Sansone et al.'s motivation. Appellant cites that, "certain rates may be dynamically increased. Such an increase may be used to dissuade customers from unnecessarily using the carrier during peak times." By the Appellant disclosing that the system dissuades the users from using the mail system during peak times, the Appellant is suggesting that the mail system prefers to operate the facilities of the post office in a more efficient and effective.

We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. *In re Dembiczak*, 50 USPQ2d 1614. Therefore, the "motivation-suggestion-teaching" test asks not merely what the references disclose, but whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims. *In re Kahn* 78 USPQ2d 1329 (CAFC 2006). Thus, someone of ordinary skill in the art would be led to combine Barns-Slavin et al. and Sansone et al.

Second Issue

Appellant argues that the phrase, "the incentive is a penalty", would be clear to one skilled in the art in view of the Specification. The Appellant further argues that, "However, in an alternative to the embodiments, certain rates may be dynamically increased. Such an increase may be used to dissuade customers from unnecessarily using the mailing channel during peak

times.” However, Examiner notes that nowhere in the Appellant’s arguments is an incentive being applied. By increasing certain rates to dissuade customers from using certain mailing channels, the system only applies a penalty to the customer who desires to utilize that mailing channel. Nowhere is an incentive to the user implied explicitly or implicitly, seeing as a customer is only penalized and never rewarded by any means for using that mailing channel. The use of the word incentive explicitly entails that the incentive rewards a customer, therefore an incentive being a penalty has the complete opposite meaning of the two words. Furthermore, the Appellant’s Specification provides no clear disclosure of the incentive being a penalty, but rather provides further conclusion that a user is penalized for using certain mailing channels.

Recent decisions have indicated that if an inventor is relying on a special meaning for terms appearing in the claims, then the special meaning must be clearly written in the specification. “Although an applicant may be his own lexicographer... nothing in the specification defines the words ‘incentive’ and ‘penalty’ differently from their ordinary meanings”, see *In Re Thrift*, 63 USPQ2d 2002, 2006 (Fed. Cir. 2002). “One purpose for examining the specification is to determine if the patentee has limited the scope of the claims.’ ...For example, an inventor may choose to be his own lexicographer if he defines the specific terms used to describe the invention ‘with reasonable clarity, deliberateness, and precision’, see *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 63 USPQ2d 1374, 1381 (Fed. Cir. 2002) and *In re Paulsen*, 31 USPQ2d 1671, 1674-75 (Fed. Cir. 1994). Therefore, the phrase, “the incentive is a penalty”, remains vague and indefinite.

Third Issue

Appellant argues that Barns-Slavin et al. fails to disclose using separate memory portions "for storing a primary rate database" and "for concurrently storing temporary rate data".

However, Examiner notes that the claim never recites that the memory portions are "separate".

The claim recites a first memory "portion", a second memory "portion"...for concurrently storing temporary rate data. Nowhere in the claims does the Appellant recite that the memory portions are separate. Barns-Slavin et al. discloses a first memory portion for storing rate data (Col. 2, lines 20-47, Col. 7, lines 7-15). Barns-Slavin et al. further discloses rate data stored in memory includes both single piece rates and group discount rates, and preferably may include special, alternative single piece rates. It is well known in the art that a database may have numerous memory portions comprising rate tables (databases). Barns-Slavin et al. further discloses that the rate table may be a floppy disk, PROM's, or other replaceable memory so that rate data may be updated from time to time (Col. 3, lines 45-49). It is also old and well known data embodied on a floppy disk, PROM's, or memory in general can be deleted, modified, and added. Therefore, any rate table or database on a memory portion, or data, can be updated or deleted without deleting another rate table or other data. Furthermore, the system of Barns-Slavin et al. discloses using predetermined requirements to determine discounted shipping costs for the group in accordance with the stored weights and stored portion of the shipping data and the stored rates (Col. 2, lines 39-47). Therefore, Barns-Slavin discloses several memory portions for determining whether the parcel qualifies for a discount.

Fourth Issue

Appellant argues that Barns-Slavin et al. fails to teaches obtaining or using incentive related usage data to determine the effectivity of the discount or whether the discount should be modified based on the incentive usage data. Examiner notes that Barns-Slavin et al. discloses determining whether the group meets the requirements for the discount and obtains data (i.e. usage data) on the amount of parcels being shipped. If the parcels meet the requirements then the group receives the discount. Further, the data processor is responsive to still another operator input signal to delete an identified parcel from the group and redetermine the discounted shipping cost if the group still meets the predetermined requirements. (Co. 2, lines 7-10, and 48-67, Col. 4, lines 48-50). Therefore, if the predetermined requirements (cumulative total dollar amount, number of pieces, or weight have been shipped using a particular class of mail), i.e. usage data, are not met or the usage data is modified, the system redetermines if the discount is still valid.

Fifth Issue

Appellant argues that Barns-Slavin et al. does not disclose "time based discount". However, Examiner notes "time-based discounts" taken in its broadest reasonable interpretation are discounts allowed only after a certain cumulative total dollar amount, number of pieces, or weight have been shipped using a particular class of service (C.2, lines 7-10). Further, a time-based discount taken broadly is applied to a parcel after the user has reached a certain threshold (certain cumulative total dollar amount, number of pieces, or weight have been shipped using a particular class of service). Further, Barns-Slavin et al. discloses rate data that may be changed

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by updating data from time to time (C. 3, lines 45-49). Therefore, the discount rates may be updated meaning that the discounts are applicable until the rates are updated with new rate tables.

Sixth Issue

Appellant argues that Barns-Slavin et al. fails to disclose, "receiving customer data for a plurality of customers." However, Examiner noted that Barns-Slavin et al. failed to *explicitly* disclose, "receiving customer [usage] data for a plurality of customers. Barns-Slavin et al. discloses receiving customer data for a plurality of customers (C. 2, lines 20-47). Therefore, if Barns-Slavin et al. discloses receiving data for a plurality of customers (i.e. group), receiving customer [usage] data for a plurality of customers is implicit within Barns-Slavin et al. Barns-Slavin et al. is a carrier management system that is used by a plurality of customers, not just a single customer. Thus, Barns-Slavin et al. discloses receiving customer data (e.g. shipping, usage, etc.) for a plurality of customers.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,

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Examiner
Art Unit 3628



Conferees:

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